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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,276	02/21/2002	Gerhard Staufer	770P010683-US (PAR)	9782
2512	7590	10/02/2003	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			KOC, GEORGE R	
		ART UNIT	PAPER NUMBER	1734

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/081,276	STAUFER ET AL.
	Examiner George R. Koch III	Art Unit 1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
 5) Claim(s) 11-14, 16, 18, 19, 26 and 27 is/are allowed.
 6) Claim(s) 1-10, 15, 17, 20, 21, 23-25 and 28-31 is/are rejected.
 7) Claim(s) 22 is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on May 7th, 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1.) Certified copies of the priority documents have been received.
 2.) Certified copies of the priority documents have been received in Application No. ____.
 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "gravity biasing of the plunger" as in claims 8 and 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings were received on May 7th, 2002. These drawings are approved with the exception of the issues above.

Claim Objections

3. Applicant is advised that should claims 8 and 17 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof of claim 8. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The language of claims 8 and 17 are identical, and both depend from claim 5. It appears possible that applicant intended for claim 17 to be dependent on claim 14.

Art Unit: 1734

4. Claims 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 21 and 22 are method claims, and are both dependent on claim 18, an apparatus claim. These claims add no structure to apparatus claim.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 8 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no description of the plunger being gravity biased in the specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-10, 15, 21, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites the limitation "said drive belt" in line 12. There is insufficient antecedent basis for this limitation in the claim - support is only present for upper drive belts and lower drive belts.

10. Furthermore, it is unclear whether this drive belt is an upper or lower drive belt. For the purposes of examination, it has been assumed that an upper drive belt was intended.

11. Claim 6 recites the limitation "said cam pin" in line 4. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 15 recites the limitations of "said cam slot" in line 1 and "said cam pin" in line 3. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 21, which is dependent on claim 18 recites the limitations of "a pivot pin" in line 2. It is unclear whether this is the same pivot pin as recited in claim 11, from which claim 21 indirectly depends.

14. Claim 28 recites the limitation "said drive element" in lines 11-12. There is insufficient antecedent basis for this limitation in the claim - support is only present for upper drive elements and lower drive elements.

15. Furthermore, it is unclear whether this drive element is an upper or lower drive element. For the purposes of examination, it has been assumed that an upper drive element was intended.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 1-3, 10, 20, 23-25 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez (US Patent 5,197,629), Simonotti (US 4,361,086) and Tsukasaki (US Patent 4,363,478)

Sanchez discloses a tape feed for a postage meter which includes a receptacle (item 80) for holding the plurality of tapes and a tape discharge opening (item 94). Sanchez also discloses that the receptacle has a second position wherein the receptacle is spaced adjacent one of the upper drive element such that a portion of the drive element extends into the slot and engages a tape in the receptacle. Sanchez discloses moving a subelement of the receptacle (item 100) with a solenoid (item 140) in order to effect the dispensing of the tapes.

Sanchez does not disclose the first position wherein the receptacle is spaced adjacent one of the upper drive element with the upper drive element out of engagement with the tape and includes a receptacle mover for moving the receptacle between first and second positions, or that the upper and lower drive elements transport an envelope through the postage meter.

Simonotti discloses that the upper and lower drive elements transport an envelope through the postage meter (see abstract). One in the art would appreciate that such drive elements allow for easy transportation of the envelope without the threat of jams and destruction of the envelope and its contents. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such a set of upper and lower drive elements in order to achieve easy transportation of the envelopes.

Tsukasaki discloses the first position wherein the receptacle is spaced adjacent one of a drive element with the upper drive element out of engagement with the tape, a receptacle mover for moving the receptacle between first and second positions (compare Figures 8 and 9 which disclose the positions, and item 21 which is the receptacle mover). One in the art would immediately appreciate that Tsukasaki's arrangement improves the quality of the sheet transfer mechanism at the expense of increased mechanical complexity. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such structures in order to improve sheet transfer quality.

As to claim 24 and 25, Sanchez as incorporated discloses the concept of utilizing rollers (items 162) and Simonotti as incorporated discloses the use of belts.

As to claim 1, which is identical to claim 23 except for the substitution of "drive element" for "drive belt", Simonotti further discloses that the drive elements are drive belts (item 21).

As to claim 2, Sanchez discloses that it is known to use a solenoid to effect the tape dispensing procedure (item 140). One in the art would appreciate that the solenoid provides effective actuation of the dispensing procedure of Tsukasaki. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such a solenoid in order to achieve easy actuation of the receptacle movement.

As to claim 3, the solenoid of Sanchez comes equipped with a plunger (item 142), which moves from an extended position to a retracted position. When the solenoid of Sanchez is in the extended position it is capable of dispensing, when the solenoid of Sanchez is in the shortened position it is in the first position which does not dispense (see column 5, lines 1-55)

As to claim 10, Sanchez discloses a pusher bar mounted in the receptacle to bias the tapes in the receptacle against the downstream wall of the receptacle, and the pusher bar (item 102) is capable of being retracted to load tapes.

As to method claim 29, Sanchez discloses a method of feeding tapes from a tape receptacle in a postage meter and having a slot therein for access to a tape in the receptacle, and a tape discharge slot. Sanchez discloses that the receptacle dispenses when a belt extends into the slot and engages a tape and pulls the leading of the tape from the receptacle through the tape discharge slot.

Sanchez does not disclose moving the receptacle away, nor does Sanchez disclose using upper and lower drive elements of an envelope feed mechanism.

Simonotti discloses using upper and lower drive elements transport an envelope through the postage meter (see abstract). One in the art would appreciate that such drive elements allow for easy transportation of the envelope without the threat of jams and destruction of the envelope and its contents. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such a set of upper and lower drive elements in order to achieve easy transportation of the envelopes.

Tsukasaki discloses using a method wherein the first position of the receptacle is spaced adjacent one of a drive element with the upper drive element out of engagement with the tape, a receptacle mover for moving the receptacle between first and second positions (compare Figures 8 and 9 which disclose the positions, and item 21 which is the receptacle mover). The receptacle is thus moved toward and away from the drive element in order to dispense the element. In Tsukasaki's case, the movement away allows dispensing while the movement towards prevents dispensing. However, it is well within the capabilities of one in the art to utilized the opposite movement as a mechanical design choice. One in the art would immediately appreciate that Tsukasaki's arrangement improves the quality of the sheet transfer mechanism at the expense of increased mechanical complexity. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such structures in order to improve sheet transfer quality.

Claim 20 is rejected on similar grounds as claim 29 above. Simonotti as incorporated discloses the uses of belts as the drive elements.

As to claim 30 and 31, Sanchez as incorporated discloses the concept of utilizing rollers (items 162) and Simonotti as incorporated discloses the use of belts.

Allowable Subject Matter

20. Claims 4-9 and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
21. The following is a statement of reasons for the indication of allowable subject matter: Claim 4 of the instant application are deemed to be a non-obvious improvement of the structure of Sanchez (5,197,629), Simonotti (4,361,086), Tsukasaki (4,363,478), Gallagher (5,373,450), and Dolan (4,739,343). The improvement consists, in the context of the limitations of claim 3, the further inclusion of a sensor positioned in the housing for sensing when a tape has been gripped by the envelope transport system as it is being moved from said receptacle and cause deenergization of said solenoid.
22. Claims 5, 7-9 and 17 of the instant application are deemed to be a non-obvious improvement of the structure of Sanchez, Simonotti, Tsukasaki, Gallagher, and Dolan. The improvement consists, in the context of the limitations of claim 3, of the receptacle having a cam arm having a cam slot therein, said plunger of said solenoid having a cam pin attached thereto, said cam pin being positioned in said cam slot to impart movement to said receptacle as said plunger is retracted and extended.
23. Claim 6 of the instant application are deemed to be a non-obvious improvement of the structure of Sanchez, Simonotti, Tsukasaki, Gallagher, and Dolan. The

improvement consists, in the context of the limitations of claim 3, of the receptacle is mounted for pivotal movement in said housing, a cam slot having a first locking portion and a second pivoting portion, a cam pin being positioned in said locking portion when said plunger is extended and in said pivoting portion as it is being retracted.

24. Claims 11-14, 16, 18-19 and 26-27 allowed.

25. The following is an examiner's statement of reasons for allowance: Claims 11-14, 16, 18-19 and 26-28 of the instant application are deemed to be a non-obvious improvement of the structure of Sanchez, Simonotti, Tsukasaki, Gallagher, and Dolan. With regard to independent claim 14, the improvement consists of the entire limitation of a "solenoid for pivoting said receptacle between its first position wherein said on of said upper drive belts is not contacting a tape in said receptacle and its second position wherein said one of said upper drive belts extends into said slot and engages a tape in the receptacle to draw the tape from said receptacle through said discharge opening into the path of the envelope feed system for engagement thereby whereby said tape is feed underneath the printheads".

With regard to independent claim 26, the improvement consists of the entire limitation of a "solenoid for pivoting said receptacle between its first position wherein said on of said upper drive elements is not contacting a tape in said receptacle and its second position wherein said one of said upper drive elements extends into said slot and engages a tape in the receptacle to draw the tape from said receptacle through said

discharge opening into the path of the envelope feed system for engagement thereby whereby said tape is feed underneath the printheads".

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

26. Claim 15, which is dependent on allowable claim 13, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

27. Claim 21, which is dependent on allowable claim 18, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

28. Claim 28, which is dependent on allowable claim 26, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (703) 305-3435 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the

applicant can communicate by calling the Federal Relay Service at 1-800-877-8339 and giving the operator the above TDD number. The examiner can normally be reached on M-Th 10-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (703) 308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



George R. Koch III
September 15, 2003



RICHARD CRISPINO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700